

REMARKS

Claim 2 has been cancelled without prejudice or disclaimer and claim 1 has been amended.

Applicant respectfully requests further examination and reconsideration of claim 1 now pending in the application.

In the event that the specification or claims should require any further amendment, the kind assistance of the Examiner in entering an Examiner's amendment will be greatly appreciated.

The last Office Action dated March 29, 2002 has been carefully considered and it is noted that:

- a) A statement over applicant's signature providing a complete post office address is required;
- b) The disclosure is objected to:
- c) Claim 2 is objected to:
- d) Claims 1 and 2 are rejected under 35 U.S.C. § 112, *second paragraph*, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and
- e) Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as

being unpatentable over AAPA
in view Kuesters.

In response to the Examiner's requirement for a statement over applicant's signature providing a complete post office address, applicant respectfully states that applicant's complete post office address is:

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1 Mark Court
Huntington, New York 11743

In view of applicant's statement made *supra* of applicant's complete post office address, applicant respectfully submits that the Examiner's grounds for the requirement for a statement over applicant's signature providing a complete post office address are no longer tenable and that the requirement should therefore be withdrawn.

In response to the Examiner's objection to the disclosure, applicant has:

- a) Amended page 9, line 13, to change "24" to --26--, as suggested by the Examiner.
- b) Amended page 11, line 9, to change "54" to --45--, as suggested by the Examiner.

In view of the amendment made *supra* to page 9, line 13, to change "24" to --26--, and the amendment made *supra* to page 11, line 9, to change "54" to --45--, applicant respectfully submits that the Examiner's grounds for the objection to the disclosure are no longer tenable and that the objection should therefore be withdrawn.

In response to the Examiner's objection to claim 2, applicant has:

1. Cancelled claim 2 without prejudice or disclaimer.
2. Amended claim 1 to include the limitations of cancelled claim 2, with **"portable"** changed to **--base--**, as required and suggested by the Examiner.

In view of the cancellation of claim 2 without prejudice or disclaimer, and the amendment made *supra* to claim 1 to include the limitations of cancelled claim 2, with **"portable"** changed to **--base--**, applicant respectfully submits that the Examiner's grounds for the objection to claim 2 are no longer tenable and that the objection should therefore be withdrawn.

In response to the Examiner's rejection of claims 1 and 2 under 35 U.S.C. § 112, *second paragraph*, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, applicant has:

1. Amended claim 1, lines 6-7, to change **"is in communication with the GPS"** to **--the golf cart is in communication with the GPS--**, as suggested by the Examiner
2. Amended claim 1, line 7, to change **"and has a display"** to **--the golf cart has a display--**, as suggested by the Examiner.

3. Amended claim 1, lines 8-10, to change **“so as to allow the base computer to determine the location of the golf cart”** to **--the golf cart and base computer are linked to the GPS to allow the base computer to determine the location of the golf cart--**, as suggested by the Examiner.

In view of the amendment made *supra* to claim 1, lines 6-7, to change **“is in communication with the GPS”** to **--the golf cart is in communication with the GPS--**, the amendment made *supra* to claim 1, line 7, to change **“and has a display”** to **--the golf cart has a display--**, and the amendment made *supra* to claim 1, lines 8-10, to change **“so as to allow the base computer to determine the location of the golf cart”** to **--the golf cart and base computer are linked to the GPS to allow the base computer to determine the location of the golf cart--**, applicant respectfully submits that the Examiner's grounds for the rejection of claims 1 and 2 under 35 U.S.C. § 112, *second paragraph*, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are no longer tenable and that the rejection should therefore be withdrawn.

In response to the Examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view Kuesters, applicant:

1. Has cancelled claim 2 without prejudice or disclaimer.
2. Has amended claim 1 to include the limitations of cancelled claim 2.

3. Will analyze amended claim 1 *infra* with reference to the numerals utilized in the drawing to assist the Examiner in the reconsideration of the claims.

Amended claim 1, the only claim on file, defines:

A system **30** for locating a golf ball **32** on a golf course **14** by a golfer using a golf cart **12**, wherein the golf course **14** has fixed objects **18** with locations and a base computer **20** that reads and triangulates the locations of the fixed objects **18** via a GPS **24**, wherein the golf cart **12** has a location and a portable computer **26** that is linked by radio communication to the base computer **20**, wherein the golf cart **12** is in communication with the GPS **24** and has a display **28** that displays the locations of the fixed objects **18** from the base computer **20**, and wherein the golf cart **12** and the base computer **20** are linked to the GPS **24** to allow the base computer **20** to determine the location of the golf cart **12** relative to the locations of the fixed objects **18** already determined and relay the location of the golf cart **12** back to the portable computer **26** that displays to the golfer on the display **28** the location of the golf cart **12** relative to the fixed objects **18** already displayed thereon, said system **30** comprising:

- a) a signal generator **34** for operatively connecting to the portable computer **26**, and generating a first signal **36** when activated;
- b) a microchip **38** disposed in the golf ball **32** and receiving said first signal **36** from said signal generator **34** and generating a second signal **40** in response thereto for receiving by the base computer **20** which triangulates the location of the golf ball **32** off the locations of the fixed objects **18** and generates a third

signal 42 in response thereto for receiving by the portable computer 26 which displays on the display 28 thereof the location of the golf ball 32 relative to the location of the golf cart 12 already displayed on the display 28 thereof so as to allow the golfer to locate the golf ball 32; and

- c) an amplifier 44 for operatively connecting to the base computer 20, and receiving and amplifying said second signal 40 from said microchip 38 for receiving by the base computer 20.

Pursuant to 37 CFR § 1.111(c), amended claim 1 defines the following advantageous distinctive features that distinguish over, and avoid, the prior art:

- a) “a signal generator for operatively connecting to the portable computer, and generating a first signal when activated”[Emphasis added];
- b) “a microchip disposed in the golf ball and receiving said first signal from said signal generator and generating a second signal in response thereto for receiving by the base computer which triangulates the location of the golf ball off the locations of the fixed objects and generates a third signal in response thereto for receiving by the portable computer which displays on the display thereof the location of the golf ball relative to the location of the golf cart already displayed on the display thereof so as to allow the golfer to locate the golf ball”[Emphasis added]; and

- c) “an amplifier for operatively connecting to the base computer, and receiving and amplifying said second signal from said microchip for receiving by the base computer”
[Emphasis added].

It was decided in *In re Miller*, 169 USPQ 597 CCPA 1971 that each and every limitation, *inter alia* those discussed *supra*, must be met in determining patentability:

“All words in a claim must be considered in judging the patentability of that claim against the prior art.”[at 600][Emphasis added]

In this same regard, the Examiner's attention is respectfully directed to the decisions in *In re Fuetterer*, 138 USPQ 217 (CCPA 1963); and *In re Ludke and Sloan*, 169 USPQ 563 (CCPA 1971).

When the system for locating a golf ball of the present invention is designed in accordance with the advantageous distinctive features of amended claim 1 discussed *supra*, *inter alia* the location of the golf ball relative to the location of the golf cart already displayed on the display is displayed on the display so as to allow the golfer to locate the golf ball relative to the golf cart.

Even though the advantageous feature of the present invention discussed *supra* may not have been disclosed and discussed specifically in the specification of the patent application as it was originally filed, it still must be relied upon as evidence of patentability, as was

decided in the decision of *In re Chu*, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995), where the Court held:

"Board of Patent Appeals and Interferences erred, in upholding obviousness rejection of applicant's claims, by concluding that claims' disclosure was matter of 'design choice,' and that the applicant's evidence and arguments to contrary are not present in specification and are therefore unpersuasive, since board is required to consider totality of record and is not free to disregard evidence and arguments presented by applicants, and since there is no support for proposition that evidence and/or arguments traversing 35 USC 103 rejection must be contained within specification, given that obviousness is determined by totality of record including, in some instances most significantly, evidence and arguments proffered during give-and-take of ex parte patent prosecution."[at 1090]
[Emphasis added]

"Because the Board was required to consider the totality of the record, the Board was not free to disregard the evidence and arguments presented by Chu in response to the obviousness rejection. Additionally, the Board erred in apparently requiring Chu's evidence and arguments responsive to the obviousness rejection to be within his specification in order

to be considered. To require Chu to include evidence and arguments in the specification regarding whether placement of the SCR catalyst in the bag retainer was a matter of "design choice" would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed."[at 1094] [Emphasis added]

"We have found no cases supporting the position that a patent applicant's evidence and/or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances, most significantly, the evidence and arguments proffered during the give-and-take of ex parte patent prosecution."[at 1095] [Emphasis added]

And, even though the present invention may be considered simple and accomplishes only a small but genuine improvement by some is not sufficient reason to deny it patent protection, as was decided in *Schnell et al. v. The Albright-Nell Company et al.*, 146 USPQ 322 (Court of Appeals, Seventh Circuit 1965), where the Court held:

"Device seems simple and obvious in light of patentee's teaching, but it evidently was not obvious at time of invention; those working in the field did not accomplish patentee's

results; that fact supports conclusion that patentee achieved patentable invention."
[at 322][Emphasis added]

"This now seems simple and obvious in the light of the Schnell teaching, but is was evidently not at all obvious at the time of the invention. Those working in the field did not accomplish Schnell's results. That fact supports the conclusion that Schnell achieved patentable inventions. Pyle Nat. Co. v. Lewin, 7 Cir., 1937, 92 F.2d 628, 630, 35 USPQ 40, 42." [at 324][Emphasis added]

The Board of Appeals expressed the same concept when it held in *Ex parte Grasenick and Gessner*, 158 USPQ 624 (Patent Office Board of Appeals 1967), that:

"Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement is obvious."[at 624][Emphasis added]

"This rejection is in error. An improvement over the prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless the prior art shows the improvement to be obvious. The examiner has neither cited evidence establishing the obviousness of appellant's modification of the prior art nor demonstrated that the improved

results claimed by appellants are not available from their construction."[at 624][Emphasis added]

Attention is also respectfully directed in this regard to the decisions in *Mercantile National Bank of Chicago et al v. Quest, Inc. et al.* DC., N.D. Indiana, 166 USPQ 517; *In re Shelby*, 136 USPQ 220; and *In re Irani and Moedritzer*, 166 USPQ 24, which all indicate that simplicity does not operate as a bar to patentability if the invention was unobvious at the time it was made.

Turning now to the references applicant respectfully submits that the Federal Circuit holds that relevant case law must be relied upon in determining obviousness *ipso facto* the determination of obviousness is a matter of law, as decided in *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ.2d 1210, 1214 (Fed. Cir. 1995), where the Court held:

"Obviousness is a question of law, which we review *de novo*, though factual findings underlying the Board's obviousness determination are reviewed for clear error. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990)."[at 1214] [Emphasis added]

And, in *Richardson-Vicks Inc. v. The Upjohn Co.*, 122 F.3d 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

"The difficulty with RVI's position is that, although the argument has merit when the issue is purely one of fact, it does not follow when the issue involves a question of law. It is black letter law that the ultimate question of obviousness is a question of law." See *Graham v. Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) (citing *Great A. & P. Tea Co. v. Supermarket Equip. Co.*, 340 U.S. 147, 155, 87 USPQ 303, 309 (1950)); *In re Donaldson Co.*, 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (*en banc*); *Texas Instruments Inc. v. Unit States Int'l Trade Comm'n*, 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1028 (Fed. Cir. 1993). And we review that legal question without deference to the trial court. See *Gardner V. TEC Sys. Inc.*, 725 F.2d 1338, 1344, 220 USPQ 777, 782 (Fed. Cir. 1984) (district court's conclusion on obviousness "is one of law and subject to full and independent review in this court"). "[at 1183] [Emphasis added]

In the seminal case of *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966), the Supreme Court articulated the requirements for a *prima facie* holding of obviousness. The Patent Office has since set forth in *MPEP* § 706.02 a three step requirement for establishing a *prima facie* case of obviousness.

The first step requires that the Examiner must set forth the differences in the claim over the applied references. The second step requires that the Examiner must set forth the proposed

modification of the reference which would be necessary to arrive at the claimed subject matter. And, the third step requires that the Examiner must explain why the proposed modification would be obvious.

The Courts require that in order to satisfy the third step for establishing a *prima facie* case of obviousness, the Examiner must identify where the prior art provides a motivating suggestion to make the modifications proposed in the second step for establishing a *prima facie* case of obviousness, as was expressed in the 1992 Federal Circuit Court decision in *In re Jones*, 958, F.2d 347, 21 USPQ.2d 1941, where the Court held:

"Before the PTO may combine the disclosures of two or more prior art references in order to establish PRIMA FACIE obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art."
[Emphasis added]

The Courts further require that even if the prior art may be modified, as suggested by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification, as was expressed in the 1992 Federal Circuit Court decision in *In re Fritch*, 922, F.2d 1260, 23 USPQ.2d 1780, where the Court held:

"In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie

case of obviousness based upon the prior art...[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead to that individual to combine the relevant teachings of the references."[Emphasis added]

Such requirements were further reflected in the 1994 Federal Circuit Court decision in *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ.2d 1377, where the Court held:

"A finding of obviousness requires that the prior art provide a teaching, suggestion, or incentive to make the claimed combination."[Emphasis added]

And further, the *Fritch* Court at 1783 held that the patent applicant may attack the Examiner's *prima facie* determination as improperly made out and tending to support a conclusion of nonobviousness:

"The patent applicant may then attack the Examiner's prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness." [Emphasis added]

In properly applying the *Graham v. John Deere Co.* test in light of, *inter alia In re Jones, In re Fritch*, and *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.* discussed *supra*, the Examiner must conduct a rigorous examination and analysis of the prior art. It appears that the Examiner has not done so.

Neither AAPA, Kuesters, nor for that matter any of the references cited by the Examiner, make any motivating suggestion that, *inter alia*:

1. With respect to advantageous distinctive feature a) of amended claim 1 discussed *supra*, the portable computer **26 (FIG. 1)** on the golf cart of AAPA can be modified to be implemented with the portable controller **70 (FIG. 1A)**, as suggested by the Examiner, let alone a desirability for such a modification.
2. With respect to advantageous distinctive feature b) of amended claim 1 discussed *supra*, the golf ball can be modified to be implemented with a microchip to generate a second signal, as suggested by the Examiner, let alone a desirability for such a modification.
3. With further respect to advantageous distinctive feature b) of amended claim 1 discussed *supra*, the base computer **20 (FIG. 1)** can be modified to be replaced with base computer **82 (FIG. 8)** of Kuesters, as suggested by the Examiner, let alone a desirability for such a modification.

4. With further respect to advantageous distinctive feature b), the display **28 (FIG. 1)** can be modified to be replaced with the portable display **90 (FIG. 8)** of Kuesters, as suggested by the Examiner, let alone a desirability for such a modification.

The Examiner has merely combined elements in a piecemeal manner in light of applicant's disclosure to show obviousness by using applicant's own specification as though it were prior art and in doing so has violated the basic mandate inherent in 35 U.S.C. § 103, as was decided in *In re Kamm and Young*, 17 USPQ 298 ff, where the Court held:

"The rejection here runs afoul of a basic mandate inherent in section 103 - that a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure shall not be the basis for a holding of obviousness."
[Emphasis added]

And, in *In re Stephens, Wenzl, and Browne*, 145 USPQ 656 (CCPA 1965), where the Court reversed a rejection on a combination of references and held:

"References may not be combined indiscriminately and with guidance from applicant's disclosure to show that the claims are unpatentable." [at 656] [Emphasis added]

"In our consideration of the record in light of appellants' arguments, we find nothing which demonstrates that the examiner and the board erred in rejecting the claims. While we

agree with appellants that references may not be combined indiscriminately and with guidance from appellants' disclosure to show that claims are unpatentable, we think the combination of references her is proper and adequately suggests the structure appellants have achieved."[at 657][Emphasis added]

And, in *Panduit Corp. v. Burndy Corporation et al.*, 180 USPQ 498 (District Court, N.D. Illinois, E. Div.), where the Court held:

"Inquiry into the patentability must be directed toward subject matter as a whole and not to elements of a combination and their individual novelty; combination which results in a more facile, economical, or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that elements are individually old." [at 498][Emphasis added]

"The inquiry into the patentability must be directed toward the subject matter as a whole and not to the elements of the claimed combination and their individual novelty, and therefore a patented combination which results in a more facile, economical or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that the

various elements of the invention are individually old. The difference between the subject matter set forth in the Re. 26,492 patent and the subject matter of the cited prior art references as a whole would not have been obvious at the time the invention was made to a person of ordinary skill in the art to which such subject matter pertains, under 35 U.S.C. 103." [at 505][Emphasis added]

And, in *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 45 USPQ.2d 1977 (Fed. Cir. 1998), where the Court held:

"Federal district court's formulation of problem confronting inventors of needles for automatic knitting machine presumes their solution to problem, namely modification of "stem segment" of needles; defining problem in terms of its solution reveals improper hindsight in selection of prior art relevant to obviousness, resulted in district court adopting overly narrow view of scope of prior art, and infected district court's determinations about content of prior art." [at 1978][Emphasis added]

"To ascertain the scope of the prior art, a court examines "the field of the inventor's endeavor," *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 620, 225 USPQ 634, 628 (Fed. Cir. 1985), and "the particular problem with which

the inventor was involved," *Stratoflex, Inc. v. Aerquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983) (quoting *In re Wood* 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)), at the "time the invention was made," see 35 U.S.C. § 103(a). The district court defined the problem as "designing the *stem segment* of a knitting needle...[to] minimize[] needle head breakage and thus maximize[] the operating speed of an industrial knitting machine." (emphasis added). The '053 patent, on the other hand, describes the inventor's problem as "providing [knitting needles] with a means which avoids head breakages or lets [breakages] start to an extent worth mentioning only at higher knitting speeds." '053 patent, col. 1, lines 48-51. The district court's formulation of the problem confronting the '053 inventors presumes the solution to the problem - modification of the stem segment. Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. See, e.g. *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971) (warning against selection of prior art with hindsight). By importing the ultimate solution into the problem facing the inventors, the district court adopted an overly narrow view of the scope of the prior art. It also infected the district court's determinations about the content

of the prior art." [at 1981][Emphasis added]

And, in *In re Rouffet*, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998), where the Court reversed the Board's decision in which the level of skill in the art being high was not sufficient to supply motivation:

"Three possible sources for motivation to combine prior art references in manner that would render claimed invention obvious are nature of problem to be solved, teachings of prior art, and knowledge of persons of ordinary skill in art; high level of skill in field of art cannot be relied upon to provide necessary motivation absent explanation of what specific understanding or technical principle, within knowledge one of ordinary skill in art, would have suggested combination, since if such rote invocation could suffice to supply motivation to combine, more sophisticated scientific fields would rarely, if ever, experience patentable technical advance." [at 1453][Emphasis added]

"Claimed low orbit satellite communication system for mobile terminals is not prima facie obvious over combination of two prior art references, even though person possessing high level of skill characteristic of this field would know to account for differences between claimed invention and prior art combination, since high level of

skill in art, without more, cannot supply required motivation to combine references, and does not overcome absence of any actual suggestion to combine; obviousness rejection will not be upheld, even where skill in art is high, absent specific identification of principle, known to one of ordinary skill, that suggests claimed combination."[at 1454]
[Emphasis added]

Regarding advantageous distinctive feature c) of amended claim 1 discussed *supra*, the Examiner has admittedly taken Official Notice of facts beyond the record by stating at page 6, sub¶ b, lines 2-6 of the last Office Action a statement that is contrary to the PTO policy in *MPEP* § 706.02(a) directing Examiners never to overlook the importance of allowing claims that properly define patentable subject matter:

"...Official Notice is taken that using an amplifier for amplifying a signal would have been old and well known in the art. See *In re Malcolm* 1942 C.D. 589; 543 O.G. 440. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to connect a well known amplifier to the base computer of AAPA in order to compensate signal attenuation to maintain the signal strength at an acceptable level."[Emphasis added]

It is improper, if not inequitable, for the Examiner to rely on this fact for evidence of the rejection, as was decided in *In re Ahlert and Kruger*, 165 USPQ 418, 420 (CCPA 1970), where the Court held:

"Facts beyond the record should not be evidence upon which a rejection is based." [Emphasis added]

Furthermore, the Examiner is not obligated to find such a rejection simply to be able to reject every claim in the application.

If the Examiner still maintains such a rejection, applicant respectfully requests that the Examiner provide a reference that shows advantageous distinctive feature c) of amended claim 1, as required by *MPEP* § 706.02(a) and *In re Ahlert* discussed *supra*, *In re Kaplan*, 229 USPQ 678, 683 (CAFC 1986); and *In re Newell*, 13 USPQ.2d 1248 (CAFC 1989), where the Court held:

"Without such concrete evidence neither the applicant nor the Examiner can make a proper determination of the state of the art or the issues relevant to either anticipation or obviousness, nor can the applicant fairly judge whether the prior art discloses the claimed invention, is capable of being combined with the other references, or is in an analogous field of art." [Emphasis added]

Or an affidavit by the Examiner detailing the Examiner's knowledge as one of ordinary skill in the art to which the present invention pertains affirming that "...Official Notice is taken that using an amplifier for amplifying a signal would have been old and well known in the art. See In re Malcolm 1942 C.D. 589; 543 O.G. 440. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to connect a well known amplifier to the base computer of AAPA in order to compensate signal attenuation to maintain the signal strength at an acceptable level."[Emphasis added], as required by 37 CFR § 1.107(b), where it is ruled that:

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons."[Emphasis added]

Applicant has provided clear and convincing evidence that neither AAPA, Kuesters, nor for that matter any of the references cited by the Examiner, accomplish applicant's result of providing an efficient system for locating a golf ball that, inter alia displays on the display the location of the golf ball relative to the location of the golf cart already displayed on the display so as to allow the golfer to locate the golf ball relative to the golf cart.

Therefore a holding of obviousness cannot be made out, as was decided by the Board of Appeals in *Ex parte Tanaka, Marushima and Takahashi*, 174 USPQ 38, where the Board held:

"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art if the prior art devices do not accomplish applicant's result."
[Emphasis added]

And, in *In re Wright*, 122 USPQ 522 (1959), where the Court held:

"...the mere aggregation of old elements that did not perform a different function is not a patentable invention, but that a novel combination of old elements which cooperate with each other to produce a new or useful result or a substantial increase in efficiency is patentable."[Emphasis added]

And, further in the en banc decision in *In re Dillon*, 919 F.2d 688, 692 (Fed. Cir. 1990), where the Court held:

"...a prima facie case of obviousness requires that the prior art suggest the claimed compositions' properties and the problem the applicant attempts to solve."[Emphasis added]

Further support for considering the results accomplished by the present invention discussed *supra* in determining patentability can be found in the decision in *In re Echerd*, 176 USPQ 321 (CCPA 1973), where the Court held:

"there is nothing inherently wrong in defining something by what it does..."[Emphasis added]

In this same regard, the Examiner's attention is respectfully directed to the decisions in *In re Halleck*, 164 USPQ 647 (CCPA 1970); and *Kockum Industries, Inc. v. Salem Equipment, Inc.*, 175 USPQ 81 (9th Cir. 1972).

In summation, since neither AAPA, Kuesters, nor for that matter any of the references cited by the Examiner, taken singularly teaches "a signal generator for operatively connecting to the portable computer, and generating a first signal when activated"[Emphasis added], "a microchip disposed in the golf ball and receiving said first signal from said signal generator and generating a second signal in response thereto for receiving by the base computer which triangulates the location of the golf ball off the locations of the fixed objects and generates a third signal in response thereto for receiving by the portable computer which displays on the display thereof the location of the golf ball relative to the location of the golf cart already displayed on the display thereof so as to allow the golfer to locate the golf ball"[Emphasis added], and "an amplifier for operatively connecting to the base computer, and receiving and amplifying said second signal from said microchip for receiving by the base computer"[Emphasis added] as defined now in amended claim 1, any hypothetical combination thereof would not lead to applicant's invention.

In light of, *inter alia* *In re Miller*, *In re Fuetterer*, *In re Chu*, *Schnell et al. v. The Allbright-Nell Company et al.*, *Ex parte Grasenick and Gessner*, *Mercantile National Bank of Chicago et al v. Quest, Inc. et al.*, *In re Shelby*, *In re Irani and Moedritzer*, *In re Deuel*, *Richardson-Vicks Inc. v. The Upjohn Co.*, the *Graham v. John Deere Co.* test in light of, *inter alia* MPEP 706.02, *In re Jones*, *In re Fritch*, and *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, *In re Kamm and Young*, *In re Stephens*, *Wenzl, and Browne*, *Panduit Corp. v. Burndy Corporation et al.*, *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, *In re Rouffet*, MPEP § 706.02(a), *In re Ahlert and Kruger*, *In re Kaplan*, *In re Newell*, 37 CFR § 1.107(b), *Ex parte Tanaka, Marushima and Takahashi*, *In re Wright*, *In re Dillon*, *In re Echerd*, *In re Halleck*, and *Kockum Industries, Inc. v. Salem Equipment, Inc.* discussed *supra*, pursuant to *In re Fritch* discussed *supra* applicant attacks the Examiner's *prima facie* determination as being improperly made out and tending to support a conclusion of nonobviousness.

In view of the cancellation of claim 2 without prejudice or disclaimer, the amendment made *supra* to claim 1 to include the limitations of cancelled claim 2, and the arguments presented *supra*, applicant respectfully submits that the Examiner's grounds for the rejection of claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view Kuesters are no longer tenable and that the rejection should therefore be withdrawn.

The prior art cited, but not relied upon, by the Examiner has been carefully considered and duly noted.

In view of the above, it is submitted that the claim is in condition for allowance.
Reconsideration and withdrawal of the objection and rejections are respectfully requested.
Allowance of claim 1 at an early date is earnestly solicited.

Respectfully submitted,

5/29/2002
Date

Cheryl Goldman
Cheryl Goldman